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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/537,271	11/22/2005	Peter Nonnenmacher	095309.56330US	1056

23911 7590 04/06/2009  
CROWELL & MORING LLP  
INTELLECTUAL PROPERTY GROUP  
P.O. BOX 14300  
WASHINGTON, DC 20044-4300

EXAMINER
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FORD, JOHN K

ART UNIT	PAPER NUMBER
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3744

MAIL DATE	DELIVERY MODE
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04/06/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/537,271	<b>Applicant(s)</b> NONNENMACHER ET AL.	
	<b>Examiner</b> John K. Ford	<b>Art Unit</b> 3744	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 8-23 is/are pending in the application.  
     4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 8-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. ____.                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>6/1/05 and 11/22/05</u> .                                     | 6) <input type="checkbox"/> Other: ____.                          |

The subject matter of claim 9 of this application admits of illustration by a drawing to facilitate understanding of the invention. Applicant is required to furnish a drawing (similar to current Figure 1) but showing the subject matter of claim 9 (see specification paragraph 0016) under 37 CFR 1.81(c). No new matter may be introduced in the required drawing. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d).

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 8-23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

To begin with, claims 8-23 are extremely similar to original claims 1-7 and the examiner adopts here as his own the critique of claims 1-7 by Examiner Joerg Czarnowski in the German Office action dated August 5, 2003. The critique, which is an extremely detailed rejection under the German equivalent of 35 USC 112, second paragraph, is incorporated here by reference as if it appeared here and applicant must address each of the points in applicant's response concerning claims 8-23 that

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Examiner Czarnowski has raised with respect to the corresponding substantially similar claims that he was examining.

In addition to Examiner Czarnowski's critique, the undersigned US examiner finds the two phrases beginning "optionally....." vague in claim 8. It is indefinite as to whether the measurement steps following the word "optionally" (i.e. solar radiation, and/or vehicle speed and /or the mass flow) are part of the method or not. The would-be infringer would not be reasonably apprised of the scope of the claim. The examiner would suggest a remedy to the problem would be to place the "optionally" limitation in a dependent claim. Also see Examiner Czarnowski's critique on this issue under his heading "S2".

Because US counsel has taken out the original parenthetical notations of the variables being claimed in the claims it has become unclear in many instances what previously recited variable applicant is referring to an earlier portion of the same claim or (with respect to a dependent claim) the claim from which it depends. The reason for this is that on many occasions the claim language takes liberties with claiming the terminology in subsequent recitations of the same variable that do not precisely correspond to the earlier recitation. To remedy this problem the examiner would suggest inserting the parenthetical notations of the variables being claimed in the claims back into the claims 8-23 in a manner similar to that employed in original claims 1-7 of this application. Alternatively, applicant must make sure that each subsequent recitation of the same variable precisely corresponds to the earlier recitation so that the reader will not be confused. Some of these variables have confusingly similar names

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that lead to interpretation problems when applicant attempts to refer to them in shorthand fashion in subsequent recitations.

Finally the subject matter of claim 9 may have to be rewritten (with the pertinent portions of claim 8 incorporated) in independent form because claim 8 already has an explicit order in which the steps are carried out that cannot be changed in a dependent claim. Dependent claims can not take a step or element away from the claim upon which they depend nor can they contradict the claim from which they depend as appears to be the situation here.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John K. Ford whose telephone number is 571-272-4911. The examiner can normally be reached on Mon.-Fri. 9-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cheryl Tyler can be reached on 571-272-4834. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/John K. Ford/  
Primary Examiner, Art Unit 3744